

IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

In re Patent Application of
MARK JAMES BECKMAN

Serial No.: 10/728,447

Filed 12/04/2003

For: PROCESS FOR ASSEMBLY
AND INSTALLATION OF A SNACK
PACKAGE ADAPTED FOR ATTACHMENT
TO A BEVERAGE CONTAINER
THEREBY ALLOWING THE
COMBINATION TO TAKE UP THE
SAME SHELF SPACE AS THE
CONTAINER ALONE FOR VENDING
AND OFF-THE SHELF
SALES WITH AUGMENTED
MARKETING ADAPTATION

ART UNIT 3654

Docket PA1.677

I hereby certify that this
correspondence is being
FILED with the United
States PATENT AND
TRADEMARK OFFICE
BY ELECTRONIC MEANS

/John E. Halamka/
John E. Halamka
Dated: 11 November 2007
Palos Verdes Estates, CA

Examiner: Rakesh Kumar

RESPONSE TO OFFICE ACTION concerning this application
mailed 06/20/2007

Honorable Commissioner of Patents and Trademarks
Washington, D. C. 20231

The Examiner being responsive to the communication filed 08
March 2007 re election of species has rejected claims 1-6, 25 and 32 and
objected to claims 7-12, 21-24 and 26-28 as being dependent upon the
rejected claims but would be allowable if rewritten.

The remaining claims 13-20 and 29-31 are withdrawn from
consideration under this application. However, because applicant timely
traversed the restriction, they may be filed as a separate application.

Claim 1 was rejected because it recites the limitation "the site" in
line 15 without sufficient antecedent basis. Further, claim 1 recites the

limitation of "the maintenance function" in line 16 without sufficient antecedent basis for this limitation in the claim. Further, claim 1 recites the limitation of "the price point" in line 29 without sufficient antecedent basis. And finally, claim 1 further recites the limitation of "the contents" in line 30 without sufficient antecedent basis for this limitation.

Applicant's attorney has amended the claims so that:

- 1) "the site" which is part of the phrase "to the site of said vending machine" has been deleted so that the process step of transportation TO SAID VENDING MACHINE is a function directed to the pre-existing vending machine, the antecedent of which is in the preamble of the claim;
- 2) "the maintenance function" which is part of the phrase "purpose of performing the maintenance function" has been modified to be a process step of maintaining the pre-existing vending machine which is in the preamble of the claim;
- 3) "the price point" which is part of the phrase "setting the price point for said product storage rack compartment" has been modified to be directed to setting the condition of the pre-existing vending machine whereby the posed contents of the product storage rack compartment are released upon the selection by the user after inserting the required funds into the pre-existing vending machine which is in the preamble of the claim; and,
- 4) "the contents" which is part of the phrase "the contents to be dispensed from said product storage rack compartment to said consumer accessible area", the antecedents of which are in the preamble of the claim as a pre-existing vending machine having an internal product storage area configured with individually selectively releasable product storage rack compartments.

This clarification of language is applied to claims 1, 2, 25 and 32 so that the allowable claims, 7-12, 21-24 and 26-28, will contain proper antecedents when all of the limitations of the claims upon which there are dependent are incorporated into the modification of said claims to achieve allowability.

As claims 3-6 depend upon claims 1 and 2, claims 3-6 should be reinstated upon the finding of allowance for claims 1 and 2 which is respectfully requested.

The Examiner has cited KAUFMAN, US 6,247,612 B1 ('612) as prior art to reject claims 1-6, 25 and 32. Applicant's attorney respectfully traverses examiners conclusion that KAUFMAN is proper prior art.

Kaufman does not combine a promotional product with a product so that the combination of promotional product and product occupies substantially the same space in the vending machine as the product alone.

Applicant's attorney respectfully asserts that the inventive step of applicant is to combine a product with a promotional product in a manner so that the combined products occupy only the space that was used for the product alone.

KAUFMAN's product occupies one space and the promotional product occupies a second space thus cutting the available product space by half.

Further, Kaufman lacks any teaching or element of a "RETAINING DEVICE" used by applicant to combine the product and the promotional product. Applicant uses the RETAINING device to combine the beverage bottle and snack into a unit which substantially occupies the same space in the vending machine as the beverage bottle alone. The retaining device secures the combination during the dispensing phase of the vending machine.

KAUFMAN does not secure the product and promotional product together. Each is dispensed separately in a two step process.

Examiner expressly finds that KAUFMAN does not disclose the container unit as comprising a beverage and a snack product. Examiner continues by finding it obvious to replace the T-shirt in KAUFMAN with a snack. As KAUFMAN still does not stuff the snack into the shirt nor make the snack and the promotional product ONE UNIT the simple substitution of a snack for a T-shirt does not cure the defects of KAUFMAN as set forth below. Applicant's inventive step of unitizing the two items (Product and Promotional Item) into one UNIT in order to occupy one space is not conceived by KAUFMAN. Kaufman expressly teaches away from the UNIT concept and requires a TWO element stuffing of the vending machine dispensed in a TWO step process.

Unlike applicant's vending process where WITH ONE STEP the beverage bottle and snack combination are dispensed as a single unit upon the payment of the required price point and selection of the item to be released from the storage area of the vending machine, Kaufman requires a TWO step process set forth in '612 in column 1, lines 49-53 as:

- 1) The customer is to pay the posted price (36) by placing funds into the payment receipt mechanism (24) and then select (26) the dispensing of an item (40) from one space within the storage

- compartment (30). Disengage the coins or token from the dispensed item (40) shown in Fig. 2 and THEN
- 2) INSERT the posted price AGAIN into the payment receipt mechanism (24) using the disengaged coins or token and select the PRODUCT (50) (such as a soda bottle) desired to be purchased there by dispensing the PRODUCT from A SECOND SPACE WITHIN the vending machine storage compartment (30) as shown in Fig. 1 being stacked (50) (40) so as each occupies a single space within the storage compartment (30).

Further, the selection of the price point in KAUFMAN is controlled by the price for the product and disregards the price of the promotional item. Applicant's invention teaches adjustment of the price point to include the value of the combined products thus increasing the possible income from a pre-existing vending machine without modification of said vending machine while taking advantage of the full capacity of said vending machine.

THUS, KAUFMAN teaches using the vending machine at only HALF capacity. Further, if the promotional product (40) is fabric as taught by KAUFMAN, the fabric is taking up refrigeration energy of the vending machine by absorbing cold which raises the overhead of the operation of the vending machine.

The applicant teaches using the vending machine at FULL capacity by combining a snack with an existing soda bottle in such a manner that the snack and soda bottle occupy substantially the same space as the soda bottle alone.

KAUFMAN lacks THE THIRD ELEMENT OF APPLICANT'S invention, THE RETAINING DEVICE (104), which keeps the snack and soda bottle together as a single item dispensed from the vending machine upon the payment of the required price (WHICH CAN BE ADJUSTED TO THE VALUE OF THE COMBINED SNACK AND SODA) thereby utilizing ALL of the individual spaces within the storage compartment (30) of the vending machine while increasing the revenue of said vending machine. One of the embodiments utilizes the "packaging ring (107)" of the beverage container as a stable platform to attach a retaining device thereby coupling the "product and promotional product as a unit" in applicant's process. No such element or function of cooperation between the product and promotional item is suggested by KAUFMAN.

For all of the above reasons, applicant's attorney respectfully requests the examiner to withdraw KAUFMAN as prior art.

With the rejection of claims 1-6, 25 and 32 based on Kaufman and the issues expressly addressed of items in claims 1, 2, 25 and 32 lacking proper antecedents applicant's attorney now focuses the discussion of a proper response to Examiner's Office Action.

Applicant's attorney has discussed why claims 1-6, 25 and 32 should not be rejected on the basis of Kaufman as Kaufman does not contain all of the elements nor does Kaufman perform the same inventive function of utilizing existing space and now focuses the discussion of respectfully traversing the examiner's conclusion that the items in claim 1 lack proper antecedents. Applicant's attorney respectfully asserts that the following discussion with supporting citation of language in the specification shows proper definition of the antecedents used in the claims, especially claims 1 and 2, in the specification and the justification for CLARIFYING the language in claims 1 and 2 without introducing new matter.

Upon reflection, applicant's attorney could have written each element in the claims with more deliberateness instead of using a series of shortened phrases for an element. Applicant's attorney has CLARIFIED claim 1 with "deliberateness" in attachment 1. Applicant's attorney asserts that each element is carefully delineated as supported by the specification and the delineation of the elements are CLARIFIED to be repeated in full language each time the element is referenced.

The dilemma facing applicant's attorney is:

- 1) If the limitations of claims 1 and 2 "as is" (using the original language of the application which examiner found lack antecedents) are simply added to the ALLOWABLE matter and submitted for review, the examiner may find all of the allowable matter claims also lack proper antecedents and thus are not in proper order for allowability.
- 2) If the language of claims 1 and 2 is "modified" to provide CLARIFICATION by means of consistent language of "antecedents" the examiner may conclude that the "clarification" adds NEW MATTER. The applicant's attorney hopes that this would not be the examiner's conclusion as the MATTER already exists in the claim but the language may not be clear to provide "proper" antecedents. The analysis of the supporting matter in the specification shows that the language in claims 1 and 2 is extensively used and supported by incorporation into what those skilled in the art associate with a VENDING MACHINE operation:
 - a) the pre-existing vending machine must be placed off SITE from the manufacturing of the beverage and snack so that it is convenient for as user to purchase from a nearby self-serve machine rather than trundle to the factory where the beverage

is produced and then trundle further to the factory where the snack is produced to obtain the same result. The term “site” is used in the specification at:

Page	Line	Page	Line	Page	Line
1	24	2	4	7	30
9	1	9	13	9	15
9	19	15	28	16	2
16	4	17	16	18	28
21	21	23	4	29	26
29	30	30	5		

With such extensive use in the specification by applicant’s attorney in conjunction with “pre-selected vending machine”, it is obvious to one skilled in the art that the pre-selected vending machine must be situated someplace and that location can readily be recognized as a “site”. This, the “antecedent” of site is included in the preamble requirement of having a pre-existing vending machine. Applicant’s attorney has clarified the language of Claims 1 and 2 by removing the limitation of “the site” and simply requiring the transportation of the products to the pre-existing vending machine (defined in the preamble) where ever the pre-existing vending machine may be situated.

Applicant’s attorney respectfully requests the examiner to remove the objection to lack of antecedent for the term “SITE”.
b) The vending machine must be maintained to insure its safe operation including that it is operating at specified temperature and that the contents of the vending machine are replenished, freshened and the funds in the machine are removed to avoid being a target for vandalism and robbery. As with the term “site” above, the term maintained is frequently used throughout the specification. Applicant’s attorney has clarified the use of the term “maintenance function” by eliminating the word “the” before the term (as the implies “said” requiring an antecedent) so that the activity well known to those skilled in the art of maintaining a vending machine becomes an activity of the process rather than a referenced limitation to an antecedent. Applicant’s attorney respectfully requests the examiner to remove the objection to the lack of antecedent for the term “THE MAINTENANCE FUNCTION”.

“Maintenance” is used in the specification at: page 2, line 4; page 3, line 25; page 3, line 28; page 4, line 1; page 4, line 5; page 5, line 6; page 5, line 26; page 6, line 2; page 6, line 12, page 7, line 19; page 7, line 30; page 9, line 1; page 9, line 10; page 9, line 15; page 9, line 19 and page 16, line 5.

“Maintained” is used on page 5, line 12 and page 9, line 25.

- c) If value is added to the products within the vending machine, a price point (page 1, line 17; page 2, line 24; page 7, line 14 and page 7, line 16) may be set for this condition. The pre-existing vending machine is defined in claims 1 and 2 as having a conditional release of contents. This condition must be adjustable as it is inconceivable that the vending machine would have a FIXED price which would require the replacement of the entire vending machine each time the price of basic ingredients or processing of the beverage changed. Applicant's attorney has clarified the term "price point" to reference the term "pre-selected vending machine configured with individually selectively releasable product storage rack compartments" and the condition for release of said selectively releasable product storage rack compartment. This condition which is well known to those skilled the art to require the consumer to deposit some form of currency into the pre-existing vending machine as a prerequisite for selecting the dispensing of an item from within said vending machine posed to be dispensed from said selectively releasable product storage rack compartment.

With this clarification, applicant's attorney respectfully requests the Examiner to withdraw the lack of proper antecedent to the term "PRICE POINT".

- d) The vending machine has individual compartments, (Page 1, line 13; Page 2, line 26; and page 15, line 29) each holding some CONTENTS desired by a customer willing to pay the amount set by the price point and selecting a certain product so that the contents of the individual compartment would be released and VENDED to the customer. Applicant's attorney has modified the language of "contents" as used in the claim to make it the object of an action within the activity of dispense (vending the product container as posed in the storage rack compartment) which is in the preamble of the claim as having the items within the pre-selected vending machine posed to be dispensed. Having a "container posed to be dispensed" is a condition of the pre-existing vending machine as set forth in the preamble is sufficient antecedent as it is assumed by the customer that the container has some CONTENTS the container will convey (dispense: page 1, line 12; page 2, line 24; page 3, line 4; page 3, line 7; page 5, line 25; page 8, line 31; and page 9, line 9) from the rack (compartment: page 1, line 13; page 2, line 26 and page 15, line 29) to the customer accessible area.

CONCLUSION

Thus, applicant's attorney has chosen to clarify the language of claims 1 and 2 and has provided strong evidence that the clarifications

do not add NEW MATTER to the claims as the "MATTER" was pre-existing in the claims and simply needed articulation and clarification rather than CREATION as some new element. The clarification is shown in Attachment 1, CALIM 1 AND 2 CLARIFIED.

This same careful clarification has been applied to the remaining claims.

CLAIM 1 and 2 CLARIFIED has been used to amend the ALLOWABLE claims 7-12, 21-24 and 26-28 to include all of the limitations of the base claim and any intervening claims and submitted herewith.

Examiner has rejected claims 2, 5 and 6 based on KAUFMAN by finding that KAUFMAN teaches "such that the assembly of the beverage and the promotional items is performed at the site of the vending machine instead of preconfigured..." Applicant's attorney respectfully traverses examiner's assertion that KAUFMAN ASSEMBLES. KAUFMAN simply stacks a product into one pigeon hole and a promotional product in a second pigeon hole. NO ASSEMBLY REQUIRED!

Applicant's attorney respectfully requests the examiner to withdraw KAUFMAN as prior art to claims 2, 5 and 6. Further, Dependent claims 3, 4, 5 and 6 should be allowable upon examiner's favorable decision on reinstating claim 1

Examiner has rejected claim 25 based on KAUFMAN. Claim 25 does not utilize a vending machine. The present invention is a process of creating a unit item for use in the off-the-shelf point of sale transaction thereby increasing the efficiency of the sale by providing a single unit to be scanned. KAUFMAN does not suggest utilizing the product and promotional product stack of elements in an off-the-shelf environment and thus applicant's attorney respectfully requests the examiner to withdraw the rejection of claim 25.

Examiner has rejected claim 32 based on KAUFMAN. Claim 32 expressly requires the assembly of the "product and promotional product" as a unit and dispensing said combination in place of a SINGLE PRODUCT from a vending machine. As KAUFMAN teaches using one space for the product and a second space for the promotional product and a TWO STEP process for dispensing the items, applicant's attorney respectfully requests the examiner to withdraw the rejection of claim 32.

A complete set of claims with each claim individually annotated and labeled with an identifier is presented in an attachment to this response and made part thereof.

A second inventor was inadvertently omitted in the rush to file the patent application. The omitted inventor, Paul Perez, has executed a Declaration and Power of Attorney which is attached hereto. Kindly update the information for this patent application to indicate Mr. Paul Perez as a co-inventor. Should Examiner require any further information or action by Applicant's Attorney to have Mr. Paul Perez added as a co-inventor at this time, please inform this office of any requirement at your earliest opportunity.

Applicant's attorney has extended the 3 month time to respond to the office action to 6 months upon the payment of the official fee of \$510.00 charged to Deposit Account 080207.

ATTACHMENTS:

- 1) claims
- 2) power of attorney of omitted inventor

Respectfully submitted,

/s John E. Halamka/
John E. Halamka
Patent Attorney
Attorney of Record